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Date: April 18, 2008By: 

Attorney Docket No. 100717-502
Confirmation No. 5606

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT : Thomas KRAHN et al
SERIAL NO. : 09/966,522
CUSTOMER NO.: 27384
FILED : September 28, 2001
FOR : MASKING BACKGROUND FLUORESCENCE AND
LUMINESCENCE IN THE OPTICAL ANALYSIS OF
BIOMEDICAL ASSAYS
ART UNIT : 1641
EXAMINER : Pensee T. Do

April 18, 2008

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

Applicant respectfully requests pre-appeal brief review of the final rejection
mailed on October 18, 2007.

Applicants respectfully submit that the Examiner has committed the following errors:

1. The Examiner has misinterpreted the scope of the instant claims.

In the amendment dated April 5, 2007, claim 17 was amended, in pertinent part, from “said dye is permeant” to “said dye is in a form that permits the fluorescent dye to permeate the membrane of a biological cell.” In the paragraph bridging pages 2-3 of the final rejection, the Examiner finds:

“[T]he specification fails *to support* such ‘form that permits the fluorescent dye to permeate the membrane’. * * * The specification fails to teach any *modification* of such dyes into a form that permeate the cell membrane. [Emphasis added.]”

Clearly, the amendment to claim 17 does not require “modification” of the fluorescent dye. The Examiner misinterprets claim 17 to require such a modification.

2. The Examiner misapplies the written description requirement.

Because the Examiner misinterprets claim 17 to require modification of dyes to a form that permeates the cell, the Examiner misapplies the written description requirement when she searches the specification for a teaching of such modification and cannot find any. Because a modification of the dyes is not, in fact, required, claim 17 satisfies the written description requirement without the need for the specification to describe such unnecessary modification.

3. The Examiner ignores the fact the specification does, in fact, teach and, thereby, “support” fluorescent dyes “in a form that permits the fluorescent dye to permeate the membrane of a biological cell.”

Applicants refer, for example, to the specification at page 4, lines 20-23, wherein solutions containing fluorescent dyes in dissolved form are disclosed. Such dye solutions are also shown in the Figures (see, for example, Figure 1, depicting solution 3 containing fluorescent dye molecules 4.) Such a solution contains the dye “in a form that permits the fluorescent dye to permeate the membrane of a biological cell.” Thus, the specification does, in fact, support such concept.

4. The Examiner completely ignores the requirement of the claims that the fluorescent dye be “in a form that permits the fluorescent dye to permeate the membrane of a biological cell” when analyzing the prior art reference Wan.

There does not appear to be a dispute that Wan discloses fluorescein conjugated to E. coli particles. See, for example, Wan’s abstract (“A microfluorometric method for phagocytosis study has been developed *using fluorescein conjugated Escherichia coli K-12 particles.*”) The E. coli particles cannot permeate the cell membrane. Indeed, Wan clearly teaches that Wan’s fluorescein-conjugated E. coli particles are taken up by phagocytosis. Consequently, in Wan’s disclosure, the fluorescein is not “in a form that

permits the fluorescent dye to permeate the membrane of a biological cell,” as required by the instant claims.

The Examiner says at the top of page 6 that:

“Since Wan teaches using the same fluorescent dyes as those in the present invention, Wan’s fluorescent dyes are permeant to the cell membrane.”

This is a clear error. The Examiner completely ignores the fact that Wan’s fluorescent dye is conjugated to E. coli and, thus, described to be in a form that is not permeant to the cell membrane. The instant claims require that the fluorescent dye be “in a form that permits the fluorescent dye to permeate the membrane of a biological cell.” Wan’s fluorescent dye has been conjugated to E. coli and, thus, rendered in a form that it cannot permeate a cell’s membrane, but must, instead, be taken up by phagocytosis. Consequently, Wan’s disclosure does not meet the terms of the instant claims.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the final rejections and allowance of claims 17-23 and 43.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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